REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 13, 2005. At the time of the Office Action, Claims 1-21 were pending in this Application. Claims 1-21 were rejected. Claims 1, 9, 10, 12, 16 and 19 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1-4, 9-11, and 16-18 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention for use of the term "unique identifier." Applicants traverse and submit that the term "unique identifier" as used in these claims satisfies 35 U.S.C. §112. A claim is indefinite where those of skill in the art would not understand what is claimed when reading the claim language in light of the specification and prosecution history. *See Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1218 (Fed. Cir. 1991).

In the present case, the term "unique identifier" as noted by the Examiner is described in the specification as a media access control (MAC) address, serial number, service tag or other suitable UID. Accordingly Applicants submit that one of skill in the art would surely understand that a unique identifier would refer to a address, number or name that uniquely identifies the component in question. Applicants further note that the term "unique identifier" is also found in the in the claims of a significant number of issued patents.

Claim 10 was rejected under 35 U.S.C. §112 for being indefinite. Applicants have amended Claim 10 to overcome this rejection.

Rejections under 35 U.S.C. §103

Claims 1, 2, 3, 8, 9, 10, 11, 15, 16, 17 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,631,442 issued to Steven M. Blumenau ("Blumenau") in view of U.S. Patent 6,003,073 issued to Ivan Solvason ("Solvason"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which

Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Blumenau reference relates to the interface between a host system and data storage systems. See Col. 1, lines 7-10. Examiner has argued that Blumenau teaches, among other steps:

> receiving user input from a second host among the multiple hosts; and
> repeating the operations of receiving replies from host, associating host names with UIDs, and causing hosts to produce completion signals, until each of the multiple hosts has been named, such the user input dictates the order in which host names are assigned to the multiple hosts.

of Claim 1, and similar limitations in Independent Claims 9 and 16. Examiner cites to the following section of Blumenau as teaching the steps above:

> When one of the hosts (e.g. host 150) initially attempts to access the data storage system 100-1 through the switch 250, the host 150 provides an access request (e.g., a poll for volume information) along with the host's unique World Wide Name (WWN) to the switch 250, as indicated at 221 in FIG. 6. The switch 250 then generates and returns a unique ID to the requesting host 150 (as shown at 224), and forwards (as shown at 222) the host's access request, the host's World Wide Name and the assigned ID to the data storage system 100-1. After the initial exchange of the World Wide Name and the unique identification ID between the hosts 150 through 152 and the switch

250, the hosts 150 through 152 thereafter use the unique identification
(ID) for any remaining data accesses to the volume 110.

Col. 22, lines 54-67. Applicants submit that the cited portion of Blumenau does not disclose, teach or suggest repeating operations of "causing hosts to produce completion signals" or naming all of the hosts "such that the user input dictates the order in which host names are assigned to the multiple hosts." As recited above, Blumenau only teaches that switch 250 provides a unique identification (ID) to a host after it initially contacts the switch 250. There is no teaching or suggestion relating to completion signals or how host names are ordered.

Examiner has conceded that Blumenau does not teach 1) in response to receiving UIDs, multiple hosts producing ready signals and 2) after associating a first host name with the UID for a first host, causing the first host to complete a completion signal. Applicants submit that if Blumenau does not teach these steps with respect to a first host, Blumenau also cannot teach similar steps for additional hosts, as detailed above.

The Solvason reference is directed towards a method and system for communicating control information from a control information generator to computer installations. Col. 1, lines 8-12. The system of Solvason would allow, for example, the interactive viewer participation in a broadcast television or radio program. See Col. 9, lines 4-10. Specifically, Examiner cites to figures 4 and 5 and the description pertaining there to as teaching the completion signal aspects of Claim 1.

Applicants note that Figures 4 and 5 (and the portions of Solvason cited by Examiner) relate frequency values that correspond to various data values. See Col 5, lines 8-14. Applicants submit that the tables shown merely show a standardized tone generation scheme and clearly do not disclose, teach or suggest 1) in response to receiving UIDs, multiple hosts producing ready signals or 2) after associating a first host name with the UID for a first host, causing the first host to complete a completion signal.

Accordingly, Applicants submit that the combination of Blumenau and Solvason fails teach every claim limitation of Independent Claims 1, 9 and 16. Additionally, Applicants submit that there is not sufficient motivation to combine the interactive television system of Solvason with the data storage interface of Blumenau. Applicants request reconsideration,

withdrawal of the rejection under 35 U.S.C. §103 and full allowance of Claims 1, 9 and 16 and Claims 2, 3, 8, 10, 11, 15, 17 and 18 that depend therefrom.

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Blumenau and Solvason as applied to Claims 1, 2, 3, 8, 9, 10, 11, 15, 16, 17 and 18 above, and further in view of U.S. Patent 6,098,116 issued to Mark Nixon et al. ("Nixon"). Claims 5, 7, 12, 14, 19 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Blumenau and Solvason as applied to Claims 1, 2, 3, 8, 9, 10, 11, 15, 16, 17 and 18 above, and further in view of U.S. Patent 6,378,068 issued to Mark J. Foster et al. ("Foster"). Claims 6, 13, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Blumenau and Solvason as applied to Claims 1, 2, 3, 8, 9, 10, 11, 15, 16, 17 and 18 above, and further in view of CD-ROM Professional, August 1, 1995, Volume 8, Issue 8 ("Gussin").

For the reasons listed above, the combinations cited above cannot render obvious claims 4, 5, 6, 7, 12, 13, 14, 19, 20 and 21 as these claims depend from claims that have been placed in condition for allowance. Accordingly, Applicants request reconsideration, withdrawal of the rejections under 35 U.S.C. §103 and full allowance of Claims 4, 5, 6, 7, 12, 13, 14, 19, 20 and 21.
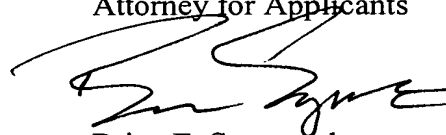
CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of Claims 1-21 as amended.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 02-0383 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2548.

Respectfully submitted,
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